



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,534	09/19/2000	Yasuyuki Yoshimura	423-P-027	5261

7277 7590 07/18/2002

HOWARD C. MISKIN
C/O STOLL, MISKIN, HOFFMAN & BADIE
EMPIRE STATE BUILDING
350 FIFTH AVE., STE. 6110
NEW YORK, NY 10118

[REDACTED] EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	7

DATE MAILED: 07/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NFE-7

Office Action Summary	Application No.	Applicant(s)
	09/665,534	YOSHIMURA ET AL.
	Examiner Callie E. Shosho	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 April 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 4/18/02.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 6-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 600205.

The rejection is adequately set forth in paragraph 4 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

4. Claims 1-4, 6-10, 12-17, and 19-33 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 10077438.

The rejection is adequately set forth in paragraph 5 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

With respect to newly amended claims 21 and 25, it is noted that JP 10077438 discloses the use of binder, i.e. resin emulsion, (paragraph 16, page 14 (11)) wherein the resin is film forming. Given that both the binder (styrene-acryl emulsion) and pigment are the same as those used in present invention, it is clear that the binder would inherently coat the pigment with same degree of roughness as presently claimed.

5. Claims 1-2, 6-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07118592.

The rejection is adequately set forth in paragraph 6 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 600205, JP 10077438, or JP 07118592 any of which of view of Yolles (U.S. 3,053,683).

The rejection is adequately set forth in paragraph 9 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

8. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 600205, JP 10077438, or JP 07118592 any of which of view of Okuda et al. (U.S. 5,510,397).

The rejection is adequately set forth in paragraph 10 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

9. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 600205 or JP 07118592 either of which in view of Morita et al. (U.S. 6,099,629).

The rejection is adequately set forth in paragraph 11 of the office action mailed 10/11/01, Paper No. 4, and is incorporated here by reference.

Response to Arguments

10. Applicants arguments with respect to Marshall et al. (U.S. 3,331,699) have been fully considered but they are rendered moot in view of the discontinuation of this reference against the present claims.
11. Applicants' arguments filed 4/18/02 have been fully considered but, with the exception of arguments relating to Marshall et al., they are not persuasive.

Specifically, applicants argue that none of the cited primary references, namely EP 600205, JP 10077438, and JP 07118592, disclose glittering ink which comprises scaly glittering particle which possess ratio of smoothness on the particle surface to median diameter of not greater than 0.011 or surface covering ratio of not greater than 80%.

Applicants argue that each of EP 600205, JP 10077438, and JP 07118592 discloses pearlescent pigment that do not provide a glittering feeling to a handwriting that glitters like stardust and that pearlescent pigment is not the glittering particle that the present invention recites.

However, given that the pigment disclosed in either EP 600205, JP 10077438, and JP 07118592, i.e. mica coated with iron oxide or titanium dioxide, is identical to that used in the present invention (see present specification pages 8, lines 3 and 12), it is the examiner's position that the ink of either EP 600205, JP 10077438, or JP 07118592 would be inherently glittering.

Evidence to support this position is found in state-of-the-art references such as Mitzutani et al. (U.S. 6,280,837) which discloses that mica pearlescent pigment such as Pearl Mica is in fact a glittering material (col.4, lines 16-20 and col.5, lines 7-9). Further, page 324 of "*Coloring Technology for Plastics*" discloses that mica pearlescent pigments exhibit different effects depending on particle size and that the effects include glitter. Given that EP 600205, JP 10077438, and JP 07118592 each disclose pearlescent pigment with particle size identical to that presently claimed, it is clear that the pearlescent pigments would, contrary to applicants' argument, provide glittering feel to the disclosed inks.

Thus, applicants' argument that pearlescent pigments such as those described in each of EP 600205, JP 10077438, and JP 07118592 cannot provide a glittering feeling is not understood. From the teaching in Mitzutani et al. and "*Coloring Technology for Plastics*", it is clear that mica pearlescent pigments such as those disclosed in EP 600205, JP 10077438, and JP 07118592 are in fact glittering particles as required in the present claims and would produce glittering ink as presently claimed.

In light of this, and given that the pigment disclosed in either EP 600205, JP 10077438, or JP 07118592 possess same average diameter as presently claimed, it is clear that the pigments would inherently possess ratio of smoothness to diameter and surface covering ratio as presently claimed. That is, in light of the teaching of Mitzutani et al. and "*Coloring Technology for Plastics*" that the pigments disclosed in either EP 600205, JP 10077438, or JP 07118592 are glittering particles, these particles must necessarily inherently possess characteristics, including those presently claimed, which make them glittering. This includes the requirement in newly added claim 30 that the glittering particle have smooth metal surface. In light of this position, the

burden now shifts to applicants to prove that the mica coated with iron oxide or titanium oxide of EP 600205, JP 10077438, and JP 07118592 which in each reference are known under the tradename Iridin, do not in fact produce glittering ink or possess characteristics as presently claimed.

With respect to Yolles, given that Yolles discloses glass flakes suitable for use in coating composition in order to produce glittery finish, it would have been obvious to one of ordinary skill in the art that glass flakes would necessarily have to possess smoothness to diameter ratio as presently claimed in order to produce such glittery finish. Further, it would have been within the skill level of one of ordinary skill in the art to recognize that if the colorant covers too much of the glittering particles, this would lower or alter the level of glittering exhibited by the ink. Thus, it would have been obvious to one of ordinary skill in the art to choose colorants with particle size in either EP 600205, JP 10077438, or JP 07118592 which would produce surface coating ratio, including that presently claimed, in order to ensure that the glittering particles are able to impart to the ink the desired level of glittering, and thereby arrive at the claimed invention.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CL.
Callie Shosho
7/12/02

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700